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OFFICE OF PETITIONS

In re Application of :
Larren F. Jones, Robert E. :
McClanahan, and Hezekiah R, :
Holland :
Application No. 09/368,503 : DECISION ON PETITION
Filed: August 5, 1999 : PURSUANT TO
Attorney Docket No. 51291.81516 : 37 C.F.R. § 1.183
Title: WEAR ASSEMBLY FOR A :
DIGGING EDGE OF AN EXCAVATOR :

This is in response to the petition pursuant to 37 C.F.R. § 1.47(a), filed July 27, 2009. This submission is being treated as a petition pursuant to 37 C.F.R. § 1.183,¹ requesting the waiver of 37 C.F.R. §§ 1.42 and 1.63(a)(1).

This petition is **DISMISSED**.

The present application is for the reissue of U.S. Patent number 5,653,048, which issued on August 5, 1997, from application number 08/554,158.

It is noted that both the written consent to the reissue by the Assignee and a statement under 37 C.F.R. § 3.73(b) were included on filing.

On August 5, 1999, the present reissue application was filed, identifying Larren F. Jones, Robert E. McClanahan, and Hezekiah R, Holland as joint inventors. A fully-executed reissue

¹ See MPEP § 603: "[w]hen an inventor who executed the original declaration is refusing or cannot be found to execute a required supplemental declaration, the requirement for that inventor to sign the supplemental declaration may be suspended or waived in accordance with 37 CFR 1.183."

declaration was included on filing. On October 27, 2008, a final Office action was mailed, which included an indication that the reissue declaration is defective and that a supplemental reissue declaration would be required.

A notice of appeal was filed on April 27, 2009, along with a three month extension of time and the associated fee. This petition pursuant to 37 C.F.R. § 1.47(a) was submitted three months later.

RELEVANT REGULATIONS AND PORTION OF THE MPEP

37 C.F.R. § 1.42 sets forth, *in toto*:

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent. Where the inventor dies during the time intervening between the filing of the application and the granting of a patent thereon, the letters patent may be issued to the legal representative upon proper intervention.

37 C.F.R. § 1.63(a) (1) sets forth, *in toto*:

(a) An oath or declaration filed under § 1.51(b) (2) as a part of a nonprovisional application must:

(1) Be executed, i.e., signed, in accordance with either § 1.66 or § 1.68. There is no minimum age for a person to be qualified to sign, but the person must be competent to sign, i.e., understand the document that the person is signing;

37 C.F.R. § 1.183 sets forth, *in toto*:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 C.F.R. § 1.175(a) sets forth, *in toto*:

(a) The reissue oath or declaration in addition to complying with the requirements of § 1.63, must also state that:

(1) The applicant believes the original patent to be wholly or partly inoperative or invalid by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than the patentee had the right to claim in the patent, stating at least one error being relied upon as the basis for reissue; and

(2) All errors being corrected in the reissue application up to the time of filing of the oath or declaration under this paragraph arose without any deceptive intention on the part of the applicant.

MPEP § 409.03(c) sets forth, *in toto*:

37 CFR 1.47 should not be considered an alternative to 37 CFR 1.42 or 35 U.S.C. 117 since the language "cannot be found or reached after diligent effort" has no reasonable application to a deceased inventor. In re Application Papers Filed September 10, 1954, 108 USPQ 340 (Comm'r Pat. 1955). See 37 CFR 1.42 and MPEP § 409.01. However, 37 CFR 1.47 does apply where a known legal representative of a deceased inventor cannot be found or reached after diligent effort, or refuses to make application. In such cases, the last known address of the legal representative must be given (see MPEP § 409.03(e)).

ANALYSIS

Along with this petition, Petitioner has submitted, *inter alia*: a Request for Continued Examination and the associated fee, a portion of the petition fee² along with the surcharge associated with the late submission of an oath or declaration, the last known address of one of the legal representatives of deceased non-signing joint inventor Jones, and a supplemental reissue declaration that has been executed by Messrs. McClanahan and Holland, as well as the brother of the deceased joint inventor.

This petition cannot be granted, as Petitioner has not asserted, much less established, the existence of an extraordinary situation such that justice requires the waiver of the requirement that the supplemental reissue declaration be executed by each of the asserted (see below) five legal representatives of the deceased joint inventor.

On renewed petition, Petitioner will need to assert the existence of an extraordinary situation, such that justice requires the waiver of the requirement that each legal representative of the deceased joint inventor must execute the supplemental reissue declaration.

Although Petitioner has asserted the existence of an extraordinary situation such that justice requires the waiver of the requirement that the supplemental reissue

² Petitioner has submitted \$130 when \$200 is due. The remaining \$200 will be charged to Deposit Account No. 19-0733 in due course, as authorized on the first page of this petition.

declaration be executed by each of the five legal representatives of the deceased joint inventor, this petition cannot be granted as the record does not support a finding that this assertion has been established. A discussion follows.

Petitioner has asserted that Mr. Jones is deceased, that an administrator was not appointed to the estate, and that there are five heirs (the five children of the deceased) "who would collectively be entitled...to make the (supplemental reissue) oath or declaration as the legal representative of the deceased inventor."³ As such, 37 C.F.R. § 1.42 indicates that each of the five heirs of the deceased joint inventor must execute the supplemental reissue oath or declaration on his behalf.

While Rule 1.47(a) is not directly applicable to the current set of facts, it does provide a similar method for rectifying situations involving the unavailability of legal representatives of a deceased joint inventor. As such, a Rule 1.47(a) analysis is being applied to determine whether an extraordinary situation is present, such that justice requires the waiver of Rule 1.63(a)(1). The applicable elements are as follows:

- (1) Petitioner must provide a statement of the last known address of each legal representative;
- (2) Petitioner must provide either -
 - a) proof that a copy of the entire application (specification, claims, drawings, and the oath or declaration) was sent or given to the legal representative for review and proof that the legal representative refuses to join in the application or
 - b) proof that the legal representative cannot be found or reached after diligent effort, and;
- (3) Petitioner must provide a supplemental declaration which complies with 37 C.F.R. § 1.175.

³ Petition, page 2. See also Daniel T. Jones declaration of facts, paragraph 4, Johnson declaration of facts, paragraph 4, and "small estate affidavit for Larren F. Jones' estate," page 2.

As noted above, there are five legal co-representatives of the deceased joint inventor.⁴ Petitioner has included a supplemental declaration that has been executed by the first two-named joint inventors and the brother of the deceased joint inventor, Mr. Daniel Thomas Jones. None of the five legal representatives have executed this supplemental declaration, and the petition is silent as to the first four named legal representatives.

It follows that requirements (1) and (2), as they apply to Randall and Patrick Jones and Mses. Morton and Harp, have not been satisfied.

Requirements (1) and (2), as they apply to Jeffrey Jones, have not been satisfied either. Petitioner has included an address for Jeffrey Jones that is outdated by at least 18 years. Petitioner has indicated that Jeffrey Jones disappeared in 1992-1992, and became "a street person in California" at that time.⁵

Petitioner has indicated that a search has been made for Jeffrey Jones, which consisted of "posting notices in newspapers in California to attempt to find him."⁶ While this method would be a likely manner of locating a street person, it carries with it the presumption that Jeffrey Jones remains a street person, while it is possible that he has established a permanent address since losing contact with his uncle 18 years ago.

Prior to filing a renewed petition, Petitioner must attempt to locate Jeffrey Jones by means such as through E-mail, telephone, and the Internet. If this search is sufficiently broad so as to provide a reasonable opportunity to locate this individual, and it is then averred that such attempts failed, then Petitioner will have provided the necessary proof that this individual cannot be reached. Details of the efforts to locate the non-signing inventor are to be set forth in an affidavit or declaration of facts by a person having first hand knowledge of the details.

Regarding the third requirement, the supplemental reissue declaration that was submitted with this petition cannot be accepted, for the following reasons:

4 Robin Morton, Jennifer Harp, Randall Jones, Patrick Jones, and Jeffrey Jones.

5 Daniel T. Jones declaration of facts, paragraphs 5-6.

6 Id. at 6.

1. The supplemental reissue declaration has not been executed by the first four legal representatives of the joint inventor.
2. Jeffrey Jones' signature on the supplemental reissue declaration has not been excused pursuant to the discussion above.
3. The supplemental reissue declaration fails to comply with 37 C.F.R. § 1.64(b), in that it fails to list the name of each of the five legal representatives of the deceased joint inventor, it fails to "state that (each) person is a legal representative," and it fails to contain the "citizenship, residence, and mailing address of (each) legal representative."

CONCLUSION

The time period for filing a renewed petition is governed by 37 C.F.R. § 1.181(f). Therefore, if reconsideration of this decision is desired, any response to this decision must be submitted within **TWO MONTHS** from the mail date of this decision, and **extensions of time under 37 C.F.R. § 1.136(a) are not permitted.** The reply should include a cover letter entitled "Renewed Petition pursuant to 37 C.F.R. § 1.183." This is not a final agency action within the meaning of 5 U.S.C § 704.

Any such renewed petition should indicate in a prominent manner that the attorney handling this matter is Senior Attorney Paul Shanoski, and may be submitted by mail,⁷ hand-delivery,⁸ or facsimile transmission (FAX).⁹ Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web.¹⁰

Telephone inquiries regarding *this decision* should be directed to Senior Attorney Paul Shanoski at (571) 272-3225.¹¹ All other

7 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

8 Customer Window, Randolph Building, 401 Dulany Street, Alexandria, VA, 22314.

9 (571) 273-8300 - please note that this is a central facsimile number.

10 <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>

11 Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for Petitioner's further action(s).

inquiries concerning examination procedures or status of the application should be directed to the Technology Center.

/Kenneth M. Schor/

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

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4/21/10